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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/798,663      | 03/11/2004  | Boyd Willat          | 29337/PP509A        | 6308             |

|                                |            |
|--------------------------------|------------|
| 7590                           | 04/10/2007 |
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|                  |  |
|------------------|--|
| EXAMINER         |  |
| WILLIAMS, MARK A |  |

|          |              |
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| ART UNIT | PAPER NUMBER |
| 3676     |              |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE  | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS                               | 04/10/2007 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/798,663

**Applicant(s)**

WILLAT ET AL.

**Examiner**

Mark A. Williams

**Art Unit**

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 54-63 and 70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 70 is/are allowed.
- 6) ☐ Claim(s) 54-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 54, 55-59, 60, 62, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al., US Patent 4,911,569, in view of David, US Patent 4,617,697.

Hashimoto provides a writing instrument comprising an elongate body (2, 46, 1) having first and second ends; a writing mechanism 23 projecting from the body first end; and a deformable sleeve 35 having a generally tubular base 44 with a first diameter and defining an inner surface engaging the body near the writing mechanism, a generally tubular outer membrane 5 with a second diameter larger than the first diameter positioned generally concentric with the base, wherein respective ends of the base and outer membrane engage to define a cavity there between, a sealable passageway 6 defined between adjacent ends of the tubular base and outer membrane in fluid communication with the cavity, and a formable

material disposed in the cavity. The base and outer membrane are integrally formed from a single piece of material. The base and outer membrane are generally cylindrical. Opposite ends of the base and outer membrane engage one another to form flat edge portions on opposite ends of the sleeve. The base inner surface is sized to frictionally engage the body. Regarding claims 56-58, as shown in figure 12, the device appears to be formed as claimed, with a 180 degree fold.

Hashimoto provides the claimed invention except teaching an annular sealable passage as claimed. David teaches the general concept of an annular sealable passage 14 as a way to join inner and outer membranes (18, 16). It would have been obvious at the time the invention was made for one skilled in the art to have modified the design of Hashimoto to include such structure, for the purpose or providing an alternative arrangement with means to join the inner and outer membranes surfaces.

Regarding claims 60, although the embodiment of figures 9-11 do not explicitly teach the base and outer membrane being bonded together, Hashimoto does further teach the concept of attaching the outer membrane to a similar base-like structure in an alternative embodiment (note figure 19). David provides teaching of a base 18 and outer membrane 16 being bonded together at 14, for the use in a handle environment. It would have been obvious at the time the invention

was made for one skilled in the art to have included in the design of Hashimoto such a modification, as generally taught by David, for the purpose of providing an alternative arrangement that would have functioned equality as well.

***Allowable Subject Matter***

5. Claim 61 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. Claim 70 is allowed.

***Response to Arguments***

Applicant's arguments with respect to the claims of record have been considered but are moot in view of new grounds of rejection.

Applicant argues that the applied art fails to show an annual sealable passageway. However, as outlined in the above rejection, David is being relied on to teach annual passage at 14, thus in combination with Hashimoto provides the claimed invention. Such a combination is considered obvious.


***Conclusion***

This action is non-final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Williams whose telephone number is (571) 272-7064. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark Williams  
4/2/07 

  
BRIAN E. GLESSNER  
SUPERVISORY PATENT EXAMINER